Introductory Remarks

Before addressing the substance of final claim rejections appearing in the most recent, April 12th Office Action, Applicant believes that a brief survey of events that have occurred during this patent application's now more than eight and one-half (8-½) year prosecution to be both illuminating and appropriate.

1. Initially, a pair of Office Actions respectively dated February 6, 2001, and June 8, 2001, and Applicant's responses thereto ended in a final rejection of all pending claims for various reasons including a rejection of independent claim 1 under 35 U.S.C. § 103(a) based upon a combination of:
   a. United States Patent no. 5,689,589 ("the Gormish, et al. patent");
   b. in view of:
      i. United States Patent no. 5,404,446 ("the Bowater, et al. patent"); and
      ii. United States Patent no. 5,838,678 ("the Davis, et al. patent").
2. Applicants appealed the final rejection of the application's claims and on December 7, 2001, filed his first appeal brief.
3. Then, a February 7, 2002, an Office Action issued which:
   a. withdrew the final rejection of claims made in the second Office Action; and

b. substituted therefore entirely new rejections of all pending claims for various reasons including a rejection of independent claim 1 under 35 U.S.C. § 102(e) based upon United States Patent no. 6,324,217 entitled "Method and Apparatus for Producing an Information Stream Having Still Images" which issued November 27, 2001, on an application filed July 8, 1998, by Donald F. Gordon ("the Gordon patent").

4. Applicant's July 19, 2002, response to the February 7th Office Action included a July 12, 2002, declaration by this application's the inventor ("the Conover Declaration") which:

a. establishes a reduction to practice for the invention disclosed and claimed in the present patent application which precedes the filing date of the Gordon patent; and

b. identifies **various errors and omissions in the Gordon patent's disclosure which render the reference's disclosure non-enabling for the invention disclosed and claimed in the present patent application**.

5. An October 11, 2002, Office Action substituted for all claim rejections appearing in the February 7th Office Action, including the rejection based upon the Gordon patent, new rejections of all pending claims including a rejection of

independent claim 1 under 35 U.S.C. § 103(a) based upon a combination of:

a. the Bowater, et al. patent"); in view of

b. United States Patent no. 5,838,678 ("the Davis, et al. patent").[1]

6. Applicant's response to the October 11th Office Action was followed by a second final rejection of claims for the reasons appearing in the October 11th Office Action.

7. Applicant appealed this final rejection of claims, and a June 7, 2005, decision the Board of Patent Appeals and Interferences ("BPAI") reversed the rejections of all claims then pending in the patent application, i.e. claims 1-7.

8. A separate, concurring opinion by only one (1) member of the three (3) judge panel, i.e. Administrative Patent Judge Barrett, **opined on an issue which was not part of the appeal**[2] and **without the benefit of reasoned argument on the subject**, that:

---

[1] The rejection appearing in the October 11th Office Action is a sub-rejection of that appearing in this application's first two (2) Office Action that Applicant appealed in the brief filed on December 7, 2001.

[2] See pages 7 and 8 of Applicant's Appeal Brief filed September 22, 2003, for a statement of "The Issues" in the second appeal.

a. the Gordon patent claimed the same patentable invention as that disclosed and claimed in this patent application; and

b. therefore a rejection of independent claim 1 based upon the Gordon patent could not be traversed by a declaration under 37 C.F.R. § 1.131.

9. Adopting Administrative Patent Judge Barretts' dicta[3] from the June 7, 2005, BPAI decision, a September 30, 2005, Office Action reverted to the rejection of independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent that first appeared in the February 7, 2002, Office Action, and was withdrawn, sub silentio, in the October 11, 2002, Office Action.

10. The Office Action that issued April 12, 2007, finally rejects this patent application's claims on the same basis as that appearing in the September 30, 2005, Office Action.

---

[3] Obiter dicta: remarks of a judge which are not necessary to reaching a decision, but are made as comments, illustrations or thoughts. Generally, obiter dicta is simply dicta. Law.COM

The April 12, 2007, Office Action

The April 12, 2007, Office Action rejects pending independent claim 1 under 35 U.S.C. § 102(e) as being anticipated by the Gordon patent.

The Conover Declaration included in the July 19, 2002, Response, for reasons outlined below, previously successfully traversed the rejection of independent claim 1 based upon the Gordon patent. As explained more thoroughly subsequently in this Response, the 2002 decision that the Conover Declaration traverses a rejection of claims based upon the Gordon patent is sound and proper because:

1. claims of the Gordon patent differ patentably from the subject matter encompassed by pending independent claim 1; and
2. even if the Gordon patent and the present application might possibly **claim** the same invention, controlling precedent bars rejecting independent claim 1 under 35 U.S.C. § 102(e) because the Gordon patent lacks an enabling disclosure of the subject matter encompassed by pending independent claim 1, i.e. pre-defined data structure NULL frames.[4]

---

[4] The **disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter**; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. Manual of Patent Examining Procedure ("MPEP") Eighth Edition Rev. 5, August 2006,

Since the Gordon patent was initially cited in the February 12, 2002, Office Action's rejection of pending independent claim 1, no Office Action or response thereto or no brief filed in Applicant's successful appeal of this application's claim rejections respectively appearing in the October 11, 2002 and March 18, 2003, Office Actions mentions the Gordon patent.[5] The complete silence regarding the Gordon patent in two (2) Office Actions subsequent to the July 19, 2002, response to the February 12, 2002, Office Action throughout an interval of more than three and one-half (3-½) years irrefutably establishes that a conclusion had been reached that the Conover Declaration successfully traverses the rejection of pending independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent.[6]

---

p. 2100-55, § 2121.01 supra citing Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003). (Emphasis supplied.)

[5] The question of sufficiency of affidavits or declarations under 37 C.F.R. § 1.131 should be reviewed and decided by a primary examiner. MPEP Eighth Edition Rev. 5, August 2006, p. 700-284, § 715.08)

[6] If it had been concluded that the Conover Declaration failed to traverse the rejection of independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent, **either the October 11, 2002, and/or March 18, 2003, Office Actions could have maintained that rejection of independent claim 1 under 35 U.S.C. § 102(e) in addition to other bases for claim rejections appearing in those two (2) subsequent Office Actions**.

Consequently, Applicant respectfully submits that the failure to mention the Gordon patent for more than three and one-half (3-½) years either in the October 11, 2002, in the March 18, 2003, Office Actions or during Applicant's successful appeal of claim rejections appearing in those two (2) Office Actions:

1. constitutes res judicata on the issue of rejecting pending independent claim 1 under 35 U.S.C. § 102(e) based upon the Gordon patent; and

2. estops[7] rejection of independent claim 1 under 35 U.S.C. § 102(e) based upon that reference now.

---

[7] Estoppel is a bar or impediment (obstruction) which precludes a person from asserting a fact or a right or prevents one from denying a fact. Such a hindrance is due to a person's actions, conduct, statements, admissions, failure to act . . . . Estoppel includes being barred by . . . , failure to take legal action until the other party is prejudiced by the delay (estoppel by laches) . . . . Law.COM

For example, regarding interference estoppel MPEP Eighth Edition Rev. 5, August 2006, p. 2300-22, § 2308.03 entitled "Estoppel Within the Office" states that there are two different types thereof.

> First, a losing party is barred on the merits from seeking a claim that would have been anticipated or rendered obvious by the subject matter of the lost count.
>
> * * *
>
> Second, **a losing party is procedurally barred from seeking from the examiner relief that could have been--but was not--sought in the interference**. (Emphasis supplied.)

AMENDMENTS

There are no **Amendments to the Specification**.

There are no **Amendments to the Claims** in the listing of claims which begins on page 11 of this Response.[8]

There are **Amendments to the Drawings**.

Remarks/Arguments begin on page 14 of this Response.

[8] The claims of this patent application were last amended almost five (5) years ago in a Response to an Office Action that was filed on July 19, 2002.